

REMARKS

With this Response, Applicants respectfully request that claims 1, 2, 4, 6, 7, 9, 11, 12, 14, 16, 17, 19, and 21 be canceled without prejudice. Claims 22-42 are currently added. Therefore, claims 22-42 are pending.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 2, 4, 6, 7, 9, 11, 12, 14, 16, 17, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,129,274 issued to Suzuki et al. (*Suzuki*) in view of U.S. Patent No. 6,105,008 issued to Davis et al. (*Davis*). Claim 21 was not addressed in the Office Action. Applicants assume that this was an unintentional oversight, and that claim 21 was meant to have been rejected under these references in like manner. Applicants have elected to cancel these claims (including claim 21) without prejudice; therefore, rejection of these claims is moot. Applicants present new claims 22-42 herein, similarly directed to the disclosure of the specification. Applicants respectfully submit that the new claims are not rendered obvious by the cited references for at least the following reasons.

Claim 22 recites the following:

serving a web page to a remote personal electronic device having a browser application to provide access to a user to products for electronic ordering via the personal electronic device;
receiving an electronic order made by the user for at least one of the products;
storing in a database user information for the user, including a user identification and a record of the electronic orders made by the user;
determining an identification of the user upon access of the web page by the user via the personal electronic device;
determining from the record a list of products previously ordered by the user;
providing automatically on the web page the list of products previously ordered by the user after determining the identification of the user;
submitting electronically a new order for a previously ordered product in response to the product being selected from the list via the personal electronic device.

Claims 29 and 36 are directed to similar subject matter, and recite limitations directed to automatically provide on the web page the list of products previously ordered by the user and submitting electronically a new order for a previously ordered product in response to the product being selected from the list.

The Office Action at page 2 cites *Suzuki* as "disclos[ing] the invention substantially as claimed." The Office Action provides no explanation as to how, or what sections of *Suzuki* are purported to disclose what elements of the claims. The Applicants respectfully note that MPEP § 2142 states:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

Applicants are unable to understand from the Office Action how *Suzuki* is purported to disclose the claim limitations previously presented. Because Applicants herein present new claims, Applicants will discuss the disclosure of *Suzuki* as understood by Applicants, and refer to the newly presented claims.

Applicants note that the references, whether alone or in combination, fail to disclose or suggest "providing automatically on [a] web page [a] list of products previously ordered by [a] user" who accesses the web page with a personal electronic device with a browser application, as recited in the claims. *Suzuki* is directed to the use of an **in-store kiosk** that is accessed via a **smart card**. See Abstract. Applicants respectfully submit that a smart card is not a remote personal electronic device having a browser application, and *Suzuki*'s kiosk does not serve a web

page to a remote personal electronic device. Thus, *Suzuki* fails to disclose or suggest every element of the claims.

The Office Action further asserts that *Davis* discloses the element of a personal electronic device at col. 8, lines 11 to 32. Applicants respectfully point out that *Davis* is directed to on-line payment with a smart card for on-line purchases. See Abstract; col. 3, line 65 to col. 4, line 25; col. 6, line 50 to col. 7, line 23. Applicants are unable to determine how *Davis*' use of a smart card to make on-line payments is purported to be related to the users-specific product-suggesting kiosk of *Suzuki* (seeing that *Suzuki*'s kiosk does **not** enable electronic ordering of products), other than the fact that both use a "smart card" for their transactions. Applicants respectfully point out that MPEP § 2143.01 requires that combining or modifying references to establish obviousness is only proper "where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." Thus, Applicants respectfully question the motivation to combine the references, and so respectfully request clarification on this point.

Furthermore, even assuming, *arguendo*, that there was a motivation to combine the references, Applicants respectfully submit that the combination of the references still fails to disclose every element of the claimed invention, as required by MPEP § 2143 to establish a *prima facie* case of obviousness. The references, whether alone or in combination, fail at least to disclose or suggest automatically providing on the web page the list of products previously ordered by the user and submitting a new order for a previously ordered product in response to the product being selected from the list, as recited in the independent claims. Therefore, the references fail to render obvious the invention as claimed.

Furthermore, dependent claims necessarily include the limitations of the independent claims from which they depend. Because claims 23-28, 30-35, and 37-42 depend, respectively, from claims 22, 29, and 36, Applicants respectfully submit that these claims are not rendered obvious by the references for at least the reasons set forth above with respect to the independent claims.

Conclusion


For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, Applicants respectfully submit that all pending claims are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
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